

REMARKS

The present amendment is submitted in response to the Office Action dated February 10, 2004, which set a three-month period for response, making this amendment due by May 10, 2004.

Claims 15-27 are pending in this application.

In the Office Action, the specification was objected to for various informalities. Claims 1-14 were rejected under 35 U.S.C. 112, second paragraph, on grounds that the claims were not presented to define the metes and bounds of the claimed invention. Claim 9 was further rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-3, 5, 9 and 14 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,971,621 to Oyafuso (" '621"). Claims 4, 6-8, and 10-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over '621.

In this amendment, the specification has been amended to delete reference to the claims, to add the suggested cross reference to the related German applications, and to add standard sectional headings.

In view of the formal rejections of the claims, claims 1-14 have been canceled and new claims 15-27 have been added. The subject matter of new claims 15-27 essentially corresponds to that of claims 1-14, respectively, but have been rewritten to adopt standard U.S. claim format for method and apparatus claims and to address the specific grounds for rejection raised in the Office Action.

The Applicant respectfully submits that the amendments to the specification and new claims 15-27 address and obviate all of the stated objections and formal rejections.

With regard to the substantive rejection of the claims, the Applicant respectfully submits that the cited references neither anticipate nor make obvious the present invention as defined in claims 15-27. New claim 15 includes a further limitation to more clearly define the present invention over the references by defining that the material displacement includes constricting the shaft 22, whereby the length of the shaft increases. Support for this limitation can be found on page 5, line 2-3 of the specification.

The patent to '621 shows an electric motor with an armature 10, which has an armature shaft 20. The length of the armature shaft 20 is predetermined by its manufacture and is not changed either before or during its installation in a housing 48. For assembly of the armature shaft 20 with a constant length, it is displaced through the opening 46 of a bearing 44, until the bearing is fixed at a predetermined point of the armature shaft 20 between the two elastic ring elements 40 and 42. Upon insertion of the armature shaft 22 into the bearing 44, the spring ring 40 is elastically deformed. However, this does not represent or equate to a material displacement (plastic).

In addition, this elastic deformation of the spring ring 40 has no effect whatsoever on the nominal dimension, in the sense of claim 15 of the present application, which represents a linear dimension of the armature shaft 22 (see Figure 1).

One object of the present invention is to compensate for an axial play of the armature shaft by changing the length of the armature shaft. This object, however, is neither stated nor resolved in the '621 reference, since in this connection, after the installation of the armature shaft 20 into the bearing 44, there is no effect on the longitudinal play at both ends of the armature shaft 20. Therefore, the practitioner receives no suggestion from the '621 reference of achieving a longitudinal change of the armature shaft by means of a plastic material deformation of the armature shaft itself, in order to compensate for its axial play in the housing.

The feature of claim 15 that the material displacement is realized by means of a constriction of the shaft 22 provides that the nominal dimension is a longitudinal dimension of the shaft 22, as shown in connection with Fig. 1, which is changed by means of the material displacement (plastic constriction). This method step is further disclosed on page 5, lines 23-24, where it states that "the shaft 22 is deformed until the length measurement of the armature shaft 22 shows the nominal dimension 44".

The term "material displacement 46" designates explicitly a plastic material deformation, that as that that occurs by means of the penetration of a non-tensioned tool into a material and is clearly distinguished from an elastic deformation of a spring ring. Likewise, both grooves 30 and 32 of '621 do not represent a material displacement, since from its shape, it can be determined that these are tensioned (the material is worn), and has no effect on a change in length of the armature shaft 20.

With regard to the rejection of the apparatus claim, the same arguments are applicable as with regard to the method claim above, since the apparatus claim also includes the above-discussed feature of claim 15. The nominal dimension 44 relates here likewise to a longitudinal dimension, which is created based on a plastic material displacement 46 according to Figure 2.

Because the '621 reference fails to disclose at least this one feature of the present invention, the rejection under Section 102 cannot stand. Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Likewise, the rejection of the claims under Section 103 cannot be maintained, since '621 offers no suggestion to the practitioner that "the material displacement includes constricting the shaft (22), whereby a length of the shaft (22) is increased". The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).


With regard to the objection to the term "actively connected", this term has been changed to "communicates with" in new claim 22, as disclosed on page 4, lines 14-15. As shown in Figure 1, this means that the endless screw 26 engages with the worm gear.

For the reasons set forth above, the Applicant respectfully submits that new claims 15-27 are patentable over the cited art. The Applicant further requests withdrawal of the rejections under 35 U.S.C. 102 and 103 and reconsideration of the claims as herein amended.

In light of the foregoing amendments and arguments in support of patentability, the Applicant respectfully submits that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



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